

REMARKS

The Examiner has rejected claims 1-16, with claims 1, 4-14, and 16 rejected under 35 U.S.C. § 102(b) as being anticipated by King U.S. Patent No. 1,556,510 and claims 2-3 and 15 rejected under 35 U.S.C. § 103(a) as being unpatentable over the King '510 patent in view of Sandberg U.S. Patent 6,604,837.

Anticipation requires the presence of a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinfabrik GmbH v. American Hoist & Derrick Co.*, 221 U.S.P.Q. 41, 45 (Fed. Cir. 1984).

Independent claims 1, 9, and 16 have all been amended to include the recitation that the illuminated magnifying device of the claims is adapted to be attached to headwear. Thus, all of the dependent claims of the application also include that limitation. This aspect of the invention allows a user to use the illuminating magnifying device hands free, such as for tying flies while fishing, during which two hands are often needed. The King '510 reference does not include such a structure. Instead, the structure of King '510 may attach to a person's head similar to eyeglasses, but does not provide a means for attaching to headwear. Because King '510 does not disclose such a structure, it cannot be anticipatory of the claims in the present application.

In order to establish a prima facie case of obviousness, three criteria must be met. M.P.E.P. § 706.02(j). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. *In re Fine*, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 230 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference or references must teach or suggest all of the claim limitations. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). There would be no expectation of success in combining the King '510 disclosure with the Sandberg device. The Examiner states that it would have been obvious to one of ordinary skill in the art to substituted Sandberg's clip with King's fastener in order to attach the device to a bill of a cap. However, the combination would not result in a workable device. Either the magnifying glass would be far too low to be useable if the clip were attached to the top of the King device (as shown in Fig. IV of the '510 patent) or the magnifying glass would be far too high and above the bill of the cap (as

Applicant : Kinsman et al.
Appln. No. : 10/667,061
Page : 6

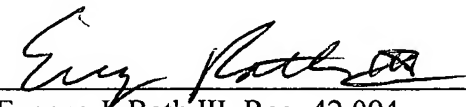
shown in Fig. 9 of the Sandberg reference) if the magnifier of the King '510 patent were inserted in place of the illumination device shown in Fig. 9 of the Sandberg reference. Either way, there would be no expectation of success and, therefore, the § 103 rejection of the claims is not proper.

CONCLUSION

The Applicants submit that the present application is in condition for allowance, a notice of which is respectfully solicited.

Respectfully submitted,

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